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09/739,857	12/18/2000	James D. Hansa	40002-10083	4208

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EXAMINER
PRATT, HELEN F

ART UNIT	PAPER NUMBER
1761	5

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Please find below and/or attached an Office communication concerning this application or proceeding.

mk-5

Application No.	Applicant(s)	
09/739,857	HANSA ET AL.	
Examiner	**Art Unit**	
Helen F. Pratt	1761	

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 77-93, 98 -121 of copending Application No. 09/739~~857~~ 456 and claims 1-7 of 09/487,036. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both require uncooked corn grits coated with flavors and nutrients. Sweeteners as in claim 7 are considered to be nutrients as in 09/739857 and as to 09/487,036 the instant claims are to contacting the oats or grits, and the '036 claims are to coating the oats by spraying. Therefore, the instant claims encompass those of '036 for claims 31-46 and 100, 101. .

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 25 is indefinite in the use of the phrase "wherein said infusion mixture is applied to the surface of the oat groats at a concentration of from about 2% to about 29% by weight of the oat groats". It is not seen how the concentration can be compared to the weight of the oat groats.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uchida et al. (5,997,917) or Morello et al. (6,283,299), or Feinstone (2,829,054).

Uchida et al. disclose an oat product made from pressed oats, which have been treated with water or an aqueous protein solution and then dried (abstract). Proteins are considered to be nutrients. Claim 1 differs from the reference in the particular amounts of nutrients on the oats and whether the oat is uncooked. However, the reference states that commercially available oats may be used (col. 2, lines 66-67). As a whey protein (WPI) isolate of from .01 to 10 % concentration is used, it is seen that the claimed amount of nutrients are absorbed onto the oats.

Morello et al. disclose an uncooked oat groat, which has been impregnated with non-native reactants, which can be simple sugars (col. 12, lines 54-55, col. 13, lines 5-12, col. 14, lines 1-10). Claim 1 differs from the reference in the particular amount of simple sugars, which have been impregnated into the groats. However, particular amounts are seen as being within the skill of the ordinary worker. The reference does disclose that enough sugars are required to create a Maillard reaction. Absent a showing that this amount is not within the claimed amount, it is seen that it would have been obvious to add nutrients and flavors such as sugars to the claimed composition as shown by Morello et al.

Feinstone discloses coating corn grits with vitamin substances and gums (col. 5, lines 1-4, 25-40, col. 6, lines 15-16). The reference discloses that the nutrients such as vitamins and chicken broth are added to rice. However, the reference discloses that corn grits can be used in place of rice (col. 5, lines 1-5). Claims 1,2, 5, 6, 7 differ from the reference in the particular amounts of material being absorbed onto the grits and in the nutrients being absorbed onto the oats. Various amounts of nutrients are added to the rice, or grits (col. 5 lines 25-35 and col. 6, lines 45-66). Certainly, if nutrients can be absorbed onto rice, they can be absorbed onto oats which is a much more porous material. As above, it the oats can absorb oats and sugars, they can absorb other known nutrients as in vitamins and mineral. Therefore, it would have been obvious to absorb the claimed materials unto grits and oats in the claimed amounts.

Claim 3 requires that the oats are whole oat groats, and claim 4 that they are cut. Uchida et al. disclose that it is known to use commercially available oats, which are

known to be whole oats in a composition (col. 2, lines 65-68). Morello et al. disclose that it is known to cut or split oat groats (col. 5, lines 45-54). Therefore, it would have been obvious to use known types of oats in the claimed uncooked product.

Claim 8 requires that particular nutrients be absorbed onto the oats or grits. Attention is invited to In re Levin, 84 USPQ 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected, and useful function. In re Benjamin D. White, 17 C.C.P.A (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221. Therefore, it would have been obvious to absorb other known ingredients onto the oats or grits.

The limitations of claims 9-16 have been discussed above and are obvious for those reasons.

Claim 17 is to the method and claim 18 drying the oats to a desired moisture concentration. Uchida et al. disclose a process of contacting pressed oats with water or

aqueous protein in amounts of from 0.1 to 3 parts by weight to 1 part of oats and then drying the oats (col. 10, lines 5-20). Claim 1 differs from the reference in the particular moisture content and in optionally equilibrating the food. However from 8-10% is within the claimed range. The claim does not positively require equilibrating the mixture and as there most likely is some time between adding the moisture and drying, it is seen that the mixture was equilibrated. Therefore, it would have been obvious to treat oats or grits with aqueous mixtures as taught by Uchida et al.

Morello et al. disclose soaking oats and adding simple sugars as disclosed in the composition claims, and drying the mixture (abstract and col. 6, lines 13-17 and col. 14, lines 1-10). Feinstone discloses spraying or submerging a vitamin dispersion mixed with HCMC in various amounts and drying the product (col. 3, lines 42-60 and col. 4, lines 55-75). The particular moisture content is seen to have been within the skill of the ordinary worker, as it is physical fact that the amount of moisture, and the type of ingredient supplied with the moisture influences the moisture content of a product. Therefore, it would have been obvious to treat a product with a liquid to a particular moisture content.

Mixing with water and nutrients is disclosed in particularly in Feinstone as in col. 6, lines 15 and 16, and lines 45-53, as in claim 19. Heating as in claim 20 is considered to have been within the skill of the ordinary worker particularly as it is known that heat helps dissolve ingredients such as salt and sugar, and the concentration of ingredients as in claim 21 is seen to have been within the skill of

the ordinary worker to vary depending on the taste and flavor required in the product. Therefore, it would have been obvious to heat the mixture and to use particular concentrations of ingredients as shown by the references above.

Morello et al. discloses various moisture contents from 7.3 -2.6 in ex. 1-4 as in claim 22 and drying at a temperature of 212 F. as in ex. 1 ("product temp after kiln") as in claim 23 and 24. Therefore, it would have been obvious to use a particular moisture content and to dry to a particular temperature.

Claim 25 requires that the infusion mixture be applied to the surface of the oats in a particular concentration. As various ingredients have been disclosed, and no particular ingredients have been claimed, so that one would know of any particular problem with applying various ingredients, in particular concentrations, it is seen that it would have been within the skill of the ordinary worker to use a particular concentration of the infusion mixture. Therefore, it would have been obvious to apply or infuse a mixture onto oats in particular concentrations for their known functions.

Nothing new is seen in the particular apparatus used for equilibrating the oats as in claim 26, in a method claim, as obviously some type of container would have been needed for such a function. Therefore, it would have been obvious to equilibrate in some type of container.

Drying as in claim 27 has been discussed above, solutions and dispersions, are disclosed in the references depending on the ingredients

required, as in claim 28, 29. Morello discloses flaking the oat groat after absorption as in claim 30 (col. 7, lines 10-25). The further limitations of claims 31-49 have been discussed above and are obvious for those reasons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen F. Pratt whose telephone number is 703-308-1978. The examiner can normally be reached on Monday 4-10 P. M., Tuesday and Wednesday, Friday, from 9:30 to 6:00 and Thursday 4-10 P. M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Milton Cano, can be reached on (703) 308-3959. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Hp 5-14-02

HELEN PRATT
PRIMARY EXAMINER